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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,501	09/14/2000	Kimiko Watanabe	SAIKP0113US	9901

7590

06/09/2004

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EXAMINER

GRANT II, JEROME

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/662,501	Applicant(s) WATANABE ET AL.	
	Examiner Jerome Grant II	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT II  
PRIMARY EXAMINER

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4</u> | 6) <input type="checkbox"/> Other: ____  |

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Detailed Action

1.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, line 11, and the throughout the claims, applicant refers to facsimile and other modes. The term other modes is vague and indefinite. Other than a fax mode any other modes have not been specifically set forth.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5 and 7-9 rejected under 35 U.S.C. 102(b) as being anticipated by Kato.

With respect to claim 1, Kato teaches a complex image processing apparatus (shown by figures 2 and 6) capable of operating as a facsimile apparatus, comprising:  
An image reading means 42 for reading information from a document; an image communicating means (modem 11 and NCU 5) for transmitting the image information

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read by the image reading means 42 and receiving image data; image forming means 9printer 18) for recording the image information as claimed; mode switching means 9switchboard 7 or pc 8) for carrying out switching among the fax mode and other modes (PC mode) Kato teaches the complex image processing apparatus being used in a fax mode in which image data can be received. Kato teaches a fax memory according to col. 9, lines 29-48 as claimed. Kato teaches a PC memory according to col. 9, lines 7-9 and 60-65 regarding the mode other than a fax mode. Kato teaches a memory control means (ROM 13) for performing control in the fax mode such that image information stored in the memory for fax is transferred to either or both of the memories for the other modes in the case where predetermined conditions are satisfied. Note col. 10, lines 6-21 where data which cannot be stored in the fax memory is transferred and stored in the PC memory.

With respect to claim 3, see col. 10, lines 6-21 where Kato teaches that when the memory in the fax is full, data is sent to the PC memory as the predetermined condition.

With respect to claim 5, Kato teaches transfer to memory when rearranged according to another criteria. According to Kato, the other criteria is the availability of memory space in the fax memory according to col. 10, lines 6-21.

With respect to claim 7, this limitation is inherent since no other conversions or formats are discussed when the fax memory is full and excess data is sent to the PC memory according to col. 10, lines 6-20.

With respect to claim 8, Kato teaches the memory for the fax (fax memory according to col. 9, lines 29-48) and PC memory is controlled by a control memory CPU 10/switch 7 or PC 8 which controls such that the image forming means records image information stored in the memory of the other mode (PC mode), on a recording medium (memory of the PC) prior to recording the image information stored in the memory of the fax.

With respect to claim 9, Kato teaches wherein the case where received image information is stored in the memory for fax (fax memory according to col. 9, lines 29-48) and in either the other modes (PC memory mode) the memory control means performs control such that the image forming means records image information stored in the memory for fax (fax memory) on a recording medium (content of the memory) prior to the recording of information on the PC memory (see col. 10, lines 6-20)

2.

Claims 2, 4, 6 and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams, can be reached on 703- 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II

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PRIMARY EXAMINER